

REMARKS/ARGUMENTS

Before this Response, claims 1-3, 5-9, 11-18 and 20 were present for examination. No claims are amended, added, or canceled. Therefore, claims 1-3, 5-9, 11-18 and 20 remain present for examination, and claims 1, 7, and 13 are the independent claims.

The Office Action dated April 7, 2006 ("Office Action") rejected claims 1-3, 5-9, 11-15, 17, 18 and 20 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,389,114 to Dowens et al. (hereinafter "Dowens"). The Office Action also rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Dowens in view of the cited portions of U.S. Publication No. 2002/0018487 to Chen et al. The Applicant respectfully traverses these rejections.

35 U.S.C. §102(e) Rejection, Dowens

Independent claims 1, 7 and 13 are rejected under 35 U.S.C. §102(e) as being anticipated by Dowens. These claims each generally provides for a *negotiation* between an originating and terminating end, which comprises selecting and determining from among a plurality of communication modes at *both* the originating and terminating ends. For a valid anticipation rejection, the Office must show that each and every limitation from the claims appears in a single prior art reference. But Dowens fails to teach or suggest *selecting* one of a plurality of personal communication modes of the originating end in the manner recited in the claims. Furthermore, the text/voice translation and contact directories of Dowens fall short of suggesting the negotiation set forth in these claimed embodiments.

1. Selecting One of a Plurality of Modes at the Originating End: The independent claims 1, 7, and 13 each generally provides for a negotiation between an originating and terminating end. To this end, the claims call for *automatically selecting* one of a *plurality* of communication modes associated with the *originating end*. The Office Action characterizes Dowens as teaching this limitation.

However, Dowens does not suggest the automatic choosing of a compatible mode from a plurality of communication modes associated with the originating end, as recited, for

example, in claim 1. The Office specifically characterizes the "email, telephone, pager, internet, etc." in Fig. 4 of Dowens as the *plurality of personal communication modes associated with the originating end* (Office Action, p. 2, sec. 3, ¶ 3. - p. 3, ¶ 1). This identification of "email, telephone, pager, internet, etc." as the communication modes set forth in Dowens focuses our analysis going forward.

The Office Action steers the discussion to the "telecommunication relay device" of Dowens which, for example, performs text-to-voice or voice-to-text conversions (Office Action, p. 3, ¶ 4 *citing* Dowens, col. 2, l. 52 - col. 3, l. 21). In Dowens, a first, initiating device (e.g., a telephone) calls a second contact device (e.g., a PDA); the telecommunication relay device acts to *convert* the voice to text, as necessary. The telecommunication relay device also acts to *convert* the text to voice for reverse communications, as well. Notably, however, the mode of an *initiating device* remains static once the call is initiated - an intermediate device, i.e., the telecommunication relay device, performs conversions. In Dowens, there is no *automatic selection* of a *compatible* communication mode at the *originating end*, as generally recited in the claims.

A closer examination of the claims further illustrates this point. Turning to independent claim 1, selecting a communication mode for the originating end comprises "determining ... compatible ... personal communication modes; and automatically choosing a compatible personal communication mode from the first plurality of personal communication modes" at the originating end. In Dowens, there is instead an intermediate *conversion* device; the automatic choosing among a plurality of modes at the originating end is absent.

Independent claim 7 further illustrates the *negotiation* set forth in the claims, and absent from the reference. In claim 7, this *negotiation* occurs when "a first personal communication between the originating end and terminating end [is initiated to] select[] the compatible personal communication mode based upon the first plurality of personal communication modes" at the originating end. The *negotiation*, therefore, occurs with this first communication. Once "the compatible personal communication mode" is selected, "a second

personal communication [is initiated] using the compatible personal communication mode." The negotiation found the claims is absent from Dowens.

Turning to the specific details of Dowens, the Office Action appears to characterize certain aspects of Dowens as reading on the claims. However, as addressed in more detail below, the conversion, or translation, of personal content does not teach the negotiation of communication modes set forth in the claims. Moreover, the use of contact directories with predetermined contact preference orders does not suggest the claimed negotiation.

2. Dowens: Content Translation: The Office Action appears to characterize Dowens as teaching this negotiation partly through text/voice *translation* of content. However, the text/voice translation in Dowens is directed to converting the content of the communication, not selecting the mode at the originating end. For example, say an originating user, O, uses a telephone to call the a terminating user, T. In Dowens, O's telephone places a call over the network to a relay device, and the relay device attempts to call T through the preferred device (e.g., a pager). Because O used a voice device, the relay will translate the voice to text for transmission to T's text-based pager. Even if O's phone is capable of communicating in a plurality of communication modes, there is no automatic selection or choosing of a compatible mode at the originating end. The originating end maintains the same mode, and simply utilizes the relay device to perform the conversion. While Dowens describes voice/text translation of the content, it fails to teach or suggest the negotiation of a compatible communication mode, wherein a compatible mode is *automatically chosen* at the *originating end*.

3. Dowens: Contact Directories: The Office Action also appears to characterize Dowens as teaching mode negotiation between communication devices at these ends through the use of contact directories (Office Action, p. 3, ¶ 3). Dowens, however, uses contact directories to attempt network connections based on a predetermined contact preference order. The negotiation between two ends, as set forth in the claims, provides that each end may be adjusted to select the compatible mode. The use of predetermined contact preference orders for conversion to the mode at a *terminating end* is substantively different from the claims.

Dowens includes a contact directory to store a *terminating user's* contact order preferences (Dowens, Fig. 4). For example, assume an originating user, O, attempts to call a terminating user, T. In Dowens, O's communication device calls a communication relay device, which looks up T's contact directory. The relay then contacts T via the first terminating device listed in the contact directory. Dowens provides no teaching or suggestion that the devices negotiate with each other to find a compatible communication mode - i.e., a compatible mode at the originating end is not automatically chosen from among a plurality of modes. The contact directory listings instead relate to possible communication devices available at the *terminating end*. Even if these terminating devices use a plurality of modes, Dowens does not suggest the automatic choosing of a compatible mode from a plurality of communication modes *at the originating end*. Dowens instead simply describes a relay device to translate communications to a preferred device at the terminating end.

Independent claims 1, 7 and 13 are allowable for at least the reasons cited above. Dependent claims 2, 3, 5, 6, 8, 9, 11, 12, 14-18 and 20 each recite limitations in addition to those in the independent claims, and these claims are believed allowable at least because of their dependence from an allowable base claim. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael L. Drapkin", written over the typed name.

Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
MLD:klb
60808779 v1